

Remarks

At the time of the Office Action claims 1-20 were pending. All claims are indicated to be rejected under 35 U.S.C. §103(a).

The Applicants respectfully requests entry of the present response since it is being submitted in accordance with 37 CFR 1.116 and the claims remain unchanged. The Applicants traverse the rejections and respectfully request reconsideration in view of the remarks that follow.

First, the Applicants turn to the rejection of claim 1 which the Examiner alleges is obvious over U.S. Patent No. 6,946,817 to Fischer et al. (hereinafter Fischer) in view of U.S. Patent No. 6,025,698 to Kim et al. (hereinafter Kim). In the rejection, the Examiner has characterized the microprocessor 20 of Fischer as being the Applicants' "control portion electrically connected with the controller." However, it appears that the Examiner has not considered nor treated the phrase "electrically connected with the controller" on the merits. To this end, the Applicants submit that the Examiner has not made a complete examination of claim 1. As stated in MPEP 2143.03, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since the Examiner has not made a complete examination, it is submitted that the rejection was improperly made Final. To this end, the Applicants respectfully request that the Examiner withdraw the finality of the last Office Action and reopen prosecution.

Given the possibility that the Examiner did not treat the controller language in the preamble (e.g., by mistakenly overlooking the corresponding language in the body of the claim) on the merits, the Applicants point to MPEP 2111.02 which states, "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." (emphasis added) See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Moreover, the Applicants call the Examiner's attention to MPEP 2111.02 citing *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d at 808-09, 62 USPQ2d at 1785 ("[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.") Because the Applicants argued in their

previous response that the controller helped distinguish claim 1 over Fischer, the Applicants submit that the Examiner should have considered the previously-added controller language.

The Applicants point out that the preamble of claim 1 was amended in their previous response to recite that the portable electronic device (which includes a battery that is charged by the claimed apparatus) “includes a controller controlling operation of the portable electronic device.” The control portion being electrically connected with a controller of the portable electronic device is an important feature of the Applicants’ apparatus because this configuration permits a battery to be charged while the battery is installed in the portable electronic device. That is, the controller communicates with the control portion to identify the battery and, therefore, the controller and control portion cooperate to charge the battery. Claim 1 was further amended in the previous response to recite the controller in the body of the claim, particularly that the control portion is electrically connected with the controller [of the portable electronic device]. The controller is shown in FIGS. 3 and 7 of the present application as reference number 78.

It can be appreciated that Fischer’s microprocessor 20 is analogous to the controller recited in claim 1 and not the Applicants’ control portion. That is, Fisher discloses at column 3, line 14-15 that “The processing device 20 controls the overall operation of the mobile device 10.” Since only certain features of Fischer are electrically connected with the microprocessor 20 (e.g., charging subsystem 16, USB controller 15, etc. according to FIG. 1 of Fischer) and since the Examiner has characterized Fischer’s charging subsystem 16 to be the Applicants’ charging portion, the Applicants submit that the rejection of claim 1 is faulty because the Applicants cannot determine what feature the Applicants’ control portion reads upon in Fischer. Although Kim (which is cited by the Examiner for its disclosure of a battery identifying signal TS and an externally connected transistor) discloses a smart battery charger 60 and a keyboard controller 80 (among other things), Kim does not disclose, teach, suggest or contemplate that a control portion is electrically connected with a controller of a portable electronic device. Since Kim cannot remedy the deficiency of Fischer (i.e., not disclosing, teaching, suggesting or contemplating a control portion electrically connected with the controller of the portable electronic device), the Applicants submit that the combination of Fischer and Kim does not disclose, teach, suggest or contemplate the Applicants’ control portion and, therefore, no prima facie obviousness exists. Furthermore, although Kim discloses a transistor 154 (as shown in FIG. 9 of Kim), this transistor 154 is part of Kim’s constant voltage regulating circuit 150 that “generates third power voltage V3 for driving the battery charge circuitry.” (col. 13, lines 52-54) Accordingly, it can be appreciated that

transistor 154 is used to drive the battery charge circuitry, not for cooperating with the control portion to “charge the battery according to the charge control signals generated by the control portion.” as is recited in claim 1. In view of the foregoing it is submitted that claim 1 and its dependent claims distinguish over the art of record.

Turning now to claim 8, the Applicants submit that the Examiner has not properly supported the prima facie obviousness rejection in view of the combination of Fischer, Kim, U.S. Patent No. 6,507, 172 to Sherman (hereinafter Sherman), and U.S. Patent No. 7,113,220 to Misawa et al. (hereinafter Misawa) because none of the references disclose, teach, contemplate or suggest the second feature recited in claim 8 – “a digital camera controller in communication with the battery recognition apparatus, the digital camera controller generating a battery selection signal that identifies the battery.” In the rejection of claim 8 the Examiner cites to a main controller (charge controller 402, FIG. 5) of Fischer. The Applicants submit that charge controller 402 of Fischer is not a digital camera controller, nor are USB controller 14 and control portion 20 of Fischer. Although Misawa (which is cited by the Examiner for a digital camera) discloses charging by USB, nevertheless, Misawa does not disclose, teach, contemplate or suggest a “digital camera controller in communication with the battery recognition apparatus, the digital camera controller generating a battery selection signal that identifies the battery.” Since none of the applied references provide a basis for the digital camera controller feature of the claim, the Applicants submit that no prima facie obviousness exists. Furthermore, the character of the Examiner’s rejection (i.e., number of references applied and lack of clarity) suggests to the Applicants that the Examiner has relied on the features of the claim as a roadmap for a hindsight reconstruction. In an obviousness rejection, it is impermissible “to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965). In view of the foregoing, it is submitted that claim 8 and its dependent claims distinguish over the art of record.

Turning now to claim 12, the Office Action states that claim 12 stands rejected under 35 U.S.C. §103(a) as being obvious over Fischer in view of Kim. However, it appears that claim 12 is being rejected as anticipated by Fischer since Kim is not applied, relied on or even mentioned by the Examiner in the rejection (see page 5 of the Office Action). Regardless, the Applicants submit that claim 12 distinguishes over Fischer when taken alone or in combination with Kim because neither of these references teach, disclose, suggest or contemplate the Applicants’ claimed USB cable for connecting a portable electronic device to

a USB receptacle (e.g., of a computer, USB hub, etc.) so that power can be transferred from the USB receptacle to a power and data port of the portable electronic device. Such a USB cable is shown in replacement FIG. 6 (previously submitted with the Applicants' response to the Office Action of April 16, 2007) as including connectors 64 and 71 electrically connected by a cable. As further shown in FIG. 3 of the present application, connector 71 of the USB cable 77 includes the charging portion and control portion of the Applicants' charging apparatus, which are claimed in claim 1. At best, Fischer discloses a conventional USB cable in Figure 1 by the two lines with double arrowheads between block 12 (USB INTERFACE) and block 22 (USB HOST OR HUB). However, Fischer's conventional USB cable cannot anticipate or render obvious the Applicants' recited USB cable of claim 12.

Even if, for argument's sake, Fischer could be properly characterized as including first and second connectors (i.e., ports - an interpretation which the Applicants dispute), the Applicants do not understand how a USB battery charger of Fischer (i.e., charging subsystem 16 of Fischer as analogized by the Examiner) could be **enclosed within** a port of charging subsystem 16. The Applicants submit that Fischer does not disclose, teach, suggest or contemplate such a configuration because a charging subsystem 16 enclosed within a port of the same charging system 16 is nonsensical. To this end, the Applicants submit that the rejection of claim 12 is specious and respectfully request that the Examiner produce authority in Fischer or in another reference that supports the Examiner's characterization of Fischer. For at least the foregoing reasons, it is submitted that claim 12 distinguishes over the art of record.

Additionally, the Applicants point out that the Examiner's analysis vis-à-vis the Applicants' "at least two wires" appears to be faulty. In particular the Examiner alleges that the Applicants' "at least two wires electrically connecting the first and second connectors" reads on the Vbus 24 and data 26 lines of Fischer. As shown in FIG. 1 of Fischer, Vbus line 24 interconnects block 12 (USB INTERFACE) with block 16 (CHARGING SUBSYSTEM) whereas data line 26 interconnects block 12 (USB INTERFACE) with block 14 (USB CONTROLLER). Since the Examiner has characterized ports of blocks 12 and 16 as being the Applicants' connectors, it appears that the Examiner's analysis of Vbus 24 and data 26 fails because **both** of these lines do not interconnect blocks 12 and 16. That is, there is only one wire (Vbus 24) between blocks 12 and 16 since data 26 connects block 14 with block 12 (block 14 is not used by the Examiner in the analysis of the Applicants' connectors). In view of the foregoing, the Applicants submit that claim 12 distinguishes over the art of record, that is, Fischer when taken alone or in combination with Kim and/or the other references

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including Sherman, Misawa, etc. In particular, the Applicants submit that the cited art of record does not disclose, teach, suggest or contemplate a USB battery charger enclosed within the second connector (e.g., a connector 71 shown in FIG. 6 that mates with the portable electronic device). Since none of the cited art references of record disclose, show or suggest the Applicants' claimed USB cable, it is submitted that claim 12 is allowable. Moreover, claims 13-20 that depend directly or indirectly from claim 12 are submitted to be allowable as well.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

Respectfully submitted,

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